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REMARKS

Applicants respectfully request reconsideration of the restriction and election requirements and the rejection of the claims over the prior art.

Continuing Traverse of Restriction and Election Requirements

In the Office Action of May 23, 2006, applicants' traverse of the earlier restriction and election requirements is acknowledged, but the restriction and election are maintained. See pages 2 and 3 of the Office Action. The undersigned attorney continues to strenuously contest the propriety of this restriction and election. As was pointed out in Applicants' response of May 9, 2006 and again in a telephone interview with Examiner Lukton on November 16, 2006, no rationale for the restriction requirement has ever been placed on the record in this application. There is no statement anywhere in the record why the USPTO considers Restriction Group I (drawn to a method for removing suspended particles from a protein solution, "and wherein there is no requirement or suggestion that a cysteine thiol group be blocked") and Restriction Group II (drawn to the method for removing suspended particles from a protein solution including a further step of blocking a cysteine thiol group) are distinct inventions requiring restriction. Such a statement is an absolute requirement for a valid restriction requirement. See MPEP §809.02(a), where step (B) of establishing a species election requires the Examiner to "[p]rovide reasons why the species are independent or distinct." The repeated failure to present any such rationale leaves the appearance that the restriction requirement is entirely arbitrary and at the whim of the Examiner. The restriction and election requirements are improper and should be withdrawn.

In their response of May 9, 2006, applicants also pointed out that claims 24-32, 42 and 43 are generic to both Groups I and II, and that prosecution of these generic claims will be necessary once Group II claims are allowed (see page 2). In his May 23, 2006 Office Action, Examiner Lukton responds that "... this is not true. None of claims 24-32, 42, 43 mention blocking of sulfhydryl groups." This statement is clearly in error.

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All of these Group I claims are drawn to a method for removing suspended particles from a protein solution, all use the inclusive transition phrase "comprising" and none include limitations which would preclude the further step of blocking a cysteine thiol group, which appears to be the step defining Group II. Accordingly, claims 24-32, 42 and 43 are generic to both 1) methods that include a further step of blocking a cysteine thiol group and 2) methods that do not include such a further step.

Furthermore, Examiner Lukton makes the following mysterious statement on page 2 of the May 23, 2006 Office action on the subject of Applicants' arguments against restriction:

"Applicants have traversed the restriction by arguing, in effect, that they are not able to see how it is possible that the Group I claims could be obvious over a given reference at the same time that Group II is not obvious over the reference."

No such argument by Applicants or the undersigned attorney appear on the record or were ever made. Applicants respectfully request that Examiner Lukton take more care not to attribute to Applicants or the undersigned attorney arguments that were not made. Applicants further request that Examiner Lukton make a statement on the record showing clear support for the above characterization of Applicants' arguments or clearly withdrawing the statement.

Obviousness-type Double Patenting Rejections

The rejection of claim 33 under the judicially-created doctrine of obviousness-type double patenting over both US 6,995,246 and co-pending application 10/873,801 are acknowledged. Any necessary terminal disclaimer will be filed if and when claim 33 is found otherwise allowable.

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Claims Are Definite

Claims 33-38 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rationale for the rejection is given as follows:

"The claims are dependent on a non-elected claim. In addition, the objective of merely "removing particles" is not consistent with the required process step, i.e., sulfitolysis of sulfhydryl groups. Some other, more suitable objective of the claimed method should be stated." See page 4.

Applicants respectfully request reconsideration and withdrawal of this rejection.

The fact that the claims depend from a non-elected claim does not make them indefinite. There is no uncertainty, whatsoever, as to which limitations are included in the elected claims. For instance, where elected claim 33 depends from non-elected claims 28, 26, 25 and 24, there is no uncertainty that all limitations of claims 24, 25, 26 and 28 are included in elected claim 33.

The fact that the preamble of the claim describes the method as "a method for removing suspended particles from a soluble protein solution" also does not make the claims indefinite. All of the instant claims require the step of "filtering the soluble protein solution through highly purified diatomaceous earth, thereby providing a clarified soluble protein solution". Accordingly, all the instant claims are a method for removing suspended particles from a soluble protein solution. The preamble is appropriate and this rejection should be withdrawn.

Claims are Non-obvious

Claims 33, 34 and 38 stand rejected under 35 U.S.C. §103 as being unpatentable over Hsu (US 6,008,328) in view of Hennen (US 6,468,534) or Colpan (US 6,274,371). Reconsideration and withdrawal of this rejection are respectfully requested. This obviousness rejection is improper because none of the references, taken individually or as a combined whole, teach or suggest the instant limitation that the filtration must take place through "highly purified" diatomaceous earth. Support for

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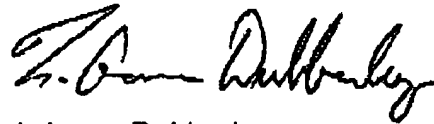
the instant claim limitation and a definition of "highly purified" diatomaceous earth can be found on page 8 of the instant specification.

Claims 33 - 38 stand rejected under 35 U.S.C. §103 as being unpatentable over Hsu (US 6,008,328) in view of Bobbitt (US 4,923,967) and further in view of Hennen (US 6,468,534) or Colpan (US 6,274,371). Reconsideration and withdrawal of this rejection are respectfully requested. This obviousness rejection is improper because none of the references, taken individually or as a combined whole, teach or suggest the instant limitation that the filtration must take place through "highly purified" diatomaceous earth. Support for the instant claim limitation and a definition of "highly purified" diatomaceous earth can be found on page 8 of the instant specification.

Interview

Examiner Lukton is thanked for his time in an interview with the undersigned attorney on November 16, 2006. All of the restriction issues identified above were discussed. No agreement was reached.

Respectfully submitted,



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